

REMARKS/ARGUMENTS

Favorable reconsideration of this application, in light of the present amendments and following discussion, is respectfully requested.

Claims 1-3, 5-7, 9-11, 13-14, 16-18, 20-21, 23-27, 29-30, 32-34, 36-37, and 39-42 are pending. Claims 1, 2, 5, 6, 9, 10, 13, 14, 16, 17, 20, 21, 23, 24, 25, 26, 29, 30, 32, 33, 36, 37, 39, 40, 41, and 42 are amended. Claims 4, 8, 12, 15, 19, 22, 28, 31, 35, and 38 are canceled without prejudice or disclaimer. Support for the amendment to Claim 1 can be found in now-canceled dependent Claim 22 and in numbered paragraphs [0052]-[0054] of the published application, for example. Support for the amendment to Claim 25 can be found in now-canceled dependent Claim 38 and in numbered paragraphs [0052]-[0054] of the published application, for example. Support for the amendments to Claims 41 and 42 can be found in numbered paragraphs [0052]-[0054] of the published application, for example. Support for the amendments to Claims 5, 6, 9, 10, 13, 14, 16, 17, 20, 21, 23, 24, 29, 30, 32, 33, 36, 37, 39 and 40 is self-evident. No new matter is added.

In the outstanding Office Action, Claims 1, 25, 41, and 42 were rejected under 35 U.S.C. § 103(a) as obvious over Midgley (U.S. Patent No. RE 35,751, herein "Midgley") in view of Official Notice. Claims 2-4, 7, 8, 10-12, 18, 19, 22, 26-28, 31, 34, 35, and 38 were rejected under 35 U.S.C. § 103(a) as obvious over Midgley in view of Kawano et al. (U.S. Patent No. 5,012,286, herein "Kawano"). Claims 5, 6, 9, 13, 14, 16, 17, 20, 21, 23, 24, 29, 30, 32, 33, 36, 37, 39, and 40 were rejected under 35 U.S.C. § 103(a) as obvious over Midgley in view of Kawano and further in view of Samuels (U.S. Patent No. 5,937,225, herein "Samuels").

Applicants note with appreciation the clarification in the outstanding Office Action indicating that Official Notice does not apply to "storing of cumulative number of prints." As for the Official Notice set forth in the outstanding Office Action regarding the calculation

aspect of the claimed subject matter, Applicants respectfully traverse the Official Notice for the same reasons as set forth in the previous response.

Regarding the rejection of Claims 1, 25, 41, and 42 as obvious over Midgley in view of Official Notice, that rejection is respectfully traversed by the present response.

Amended independent Claim 1 recites, in part:

a controller configured to store a limit number of prints particular to the replaceable part in said first nonvolatile storing means, storing, after an image forming operation, a cumulative number of prints printed by said replaceable part in said first nonvolatile storing means at least until the replaceable part is replaced with a different replaceable part and in said second nonvolatile storing means, and reporting a time for replacing said replaceable part when said cumulative number stored in said first nonvolatile storing means exceeds said limit number of prints stored in said first nonvolatile storing means,

wherein the controller is configured to determine an image forming condition setting and to increment a cumulative number stored in memory in the apparatus body by a number other than one for each of the prints sequentially output with the replaceable part while the image forming condition setting is set to a first of at least two available image forming condition settings.

Accordingly, the controller is configured to determine an image forming condition setting.

The controller increments a cumulative number of prints stored in memory in the apparatus body by a number other than one for each of the prints sequentially output by the replaceable part if the image forming condition setting is set to a first of at least two available image forming condition settings. Thus, each print printed by the image forming apparatus when the image forming condition setting is set to the first setting can be counted as **more than one print or less than one print**.¹

In contrast, Midgley merely describes one-by-one counting of prints in a count memory (112).² Midgley fails to teach or suggest altering the increment or decrement created by printing one sheet to any other number besides one. Accordingly, Midgley fails to teach

¹ See numbered paragraphs [0052-0054] for a non-limiting example.

² Midgley, col. 7, lines 20-22.

or suggest all of the features recited in amended independent Claim 1, and amended independent Claim 1 patentably distinguishes over Midgley for at least the reasons discussed above.

The outstanding Office Action relies on Official Notice for the proposition that disclosure of a method of decrementing a starting value and tracking that starting value until the starting value reaches zero, and maintaining the tracked value in a printer cartridge qualifies as storage of a cumulative number of prints made in an apparatus body.³ However, Applicants respectfully submit that no reasonable combination of Midgley and the Official Notice taken in the outstanding Office Action would include a controller configured to determine an image forming condition setting and to increment a cumulative number of prints by a number other than one for each of the prints sequentially output while the setting is set to a first of at least two available image forming settings as recited in amended independent Claim 1. Accordingly, Applicants respectfully submit that amended independent Claim 1 patentably distinguishes over Midgley and the Official Notice taken in the outstanding Office Action for at least the reasons discussed above.

Additionally, regarding the Official Notice that "storage of information in a particular area is known in the art and one of ordinary skill in the art knows the advantages..." Applicants note with appreciation that a reference, Beard et al. (U.S. Patent No. 6,016,409, here "Beard"), has been provided for review. However, Applicants respectfully note that the memory used to store the cumulative number of prints in Beard is a "customer replaceable unit monitor" or (CRUM). The (CRUM) is a module replaceable by a user and is not "readable nonvolatile storing means built in said apparatus body" as recited in independent Claim 1.

³ Outstanding Office Action, page 6.

Additionally, assuming *arguendo* that the memory described in Beard correlates to the readable nonvolatile storing means built in said apparatus body recited in Claim 1, Applicants respectfully submit that the mere disclosure in one references of one of the elements recited in a claim does not mean that a person of ordinary skill in the art would be motivated to **modify** another reference, which solves a problem differently than the first reference, so as to produce the combination of all the elements recited in the claim.

Amended independent Claims 25, 41, and 42 each recite substantially similar features to those discussed above regarding amended independent Claim 1 and patentably distinguish over any proper combination of Midgley and the Official Notice taken in the outstanding Office Action for at least the same reasons as amended independent Claim 1 does.

Regarding the rejection of Claims 2-4, 7, 8, 10-12, 18, 19, 22, 26-28, 31, 34, 35, and 38 as obvious over Midgley in view of Kawano, that rejection is respectfully traversed by the present response.

As Claims 4, 8, 12, 19, 22, 28, 31, 35, and 38 are canceled, Applicants respectfully submit that the rejection of these claims is moot.

Claims 2, 3, 7, 10, 11, 18, 26, 27, and 34 each depend from one of amended independent Claims 1 and 25 and patentably distinguish over any proper combination of Midgley and Official Notice for at least the same reasons as amended independent Claims 1 and 25 do.

Kawano fails to remedy the deficiencies discussed above regarding Midgley and Official Notice. Rather, Kawano describes an image forming apparatus including a means for comparing concentration signals correlated to toner concentrations. Kawano does not provide a controller that is configured to increment a stored cumulative number of prints by a number other than one for each of the prints output by its printer cartridge while an image forming condition setting is set to a first of at least two available image forming condition

settings. Rather, Kawano merely updates a number of prints stored in a memory (122) one-by-one each time the cartridge performs a printing operation.⁴ Accordingly, Applicants respectfully submit that no reasonable combination of Midgley and Kawano would include all of the features recited in either of amended independent Claims 1 and 25, and dependent Claims 2, 3, 7, 10, 11, 18, 26, 27, and 34 patentably distinguish over Midgley and Kawano for at least the same reasons as amended independent Claims 1 and 25 do.

Regarding the rejection of Claims 5, 6, 9, 13, 14, 16, 17, 20, 21, 23, 24, 29, 30, 32, 33, 36, 37, 39, and 40, that rejection is respectfully traversed by the present response.

Each of Claims 5, 6, 9, 13, 14, 16, 17, 20, 21, 23, 24, 29, 30, 32, 33, 36, 37, 39, and 40, depends from one of amended independent Claims 1 and 25, these claims patentably distinguish over Midgley and Kawano for at least the same reasons as amended independent Claims 1 and 25 do.

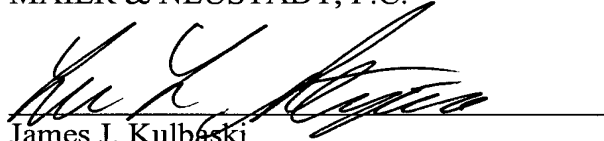
Samuels fails to remedy the deficiencies discussed above regarding Midgley and Kawano. Rather, Samuels describes a method of monitoring toner used in a printer cartridge by counting pixels printed by the cartridge, Samuels does not count prints. Accordingly, Applicants respectfully submit that Claims 5, 6, 9, 13, 14, 16, 17, 20, 21, 23, 24, 29, 30, 32, 33, 36, 37, 39, and 40, patentably distinguish over any proper combination of Midgley, Kawano, and Samuels for at least the reasons discussed above.

⁴ Kawano, col. 7, lines 42-44.

Consequently, in light of the above discussion and in view of the present amendments, the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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